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In re Patent No. 6,798,443 :  
Issue Date: September 28, 2004 :  
Francis Maguire : ON PETITION  
Application No. 09/772,016 :  
Filed: January 29, 2001 :  
Attorney Docket No. 313-008-2 :

This is in response to the PETITION TO ACCEPT UNINTENTIONALLY DELAYED CLAIM FOR THE BENEFIT OF A PRIOR APPLICATION UNDER 35 U.S.C. §120 (37 C.F.R. §1.78(a)(3)) filed November 12, 2012, requesting correction of the claim by way of issuance of a certificate of correction.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. 120, 365(c) and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. See MPEP Section 201.11, Reference to Prior Nonprovisional Applications.

This petition does not include an amendment or a supplemental Application Data Sheet (ADS) pursuant to 37 CFR 1.78(a)(2)(i) or 37 CFR 1.78(a)(5)(i). Effective with applications filed on or after September 16, 2012, the reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an application data sheet. Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48776 (August 14, 2012).

More importantly, the petition is not grantable as it requests addition of a priority claim under 35 U.S.C. 119(e) to provisional application No. 60/124,642, where such claim was not properly made during the pendency of this application. In order for petitioner to so claim the provisional application, the claim under 119(e) must have been properly made in intermediate application No. 09/524,491 and in this application during its pendency. This application matured into patent No. 7,400,917 on September 28, 2004. Unfortunately, it does not appear that either the claim under 120 to nonprovisional application No. 09/524,491 or the benefit of the provisional application under 35 U.S.C. 119(e) were properly claimed during the pendency of this application. (It is noted that the '491 application was filed prior to November 29, 2000).

Petitioner is advised that under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under 35 U.S.C. 119(e) for an application filed on or after November 29, 2000.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during

the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application. (emphasis added).

A Certificate of Correction is NOT a valid mechanism for adding or correcting a priority claim under 35 U.S.C. 119(e) after a patent has been granted on an application filed on or after November 29, 2000. See MPEP 1481.03.

Thus, the filing of a reissue application may be appropriate. See MPEP 1402.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3219.

/Nancy Johnson/

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